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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,070	07/28/2003	Thomas Seiler	71003	6155
7590 10/05/2004				
McGLEW AND TUTTLE, P.C. SCARBOROUGH STATION SCARBOROUGH, NY 10510-0827			EXAMINER EVANISKO, LESLIE J	
			ART UNIT 2854	PAPER NUMBER

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/629,070	SEILER ET AL.	
	Examiner	Art Unit	
	Leslie J. Evanisko	2854	AC

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09/21/2004 & 07/30/2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-18, drawn to a process for setting a crop mark, in the reply filed on July 30, 2004 (and duplicate copy of the reply as filed on 09/21/2004) is acknowledged.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Claim Objections***

3. Claims 1-15 and 17-18 are objected to because of the following informalities:

With respect to claim 1, it is suggested that the term "the crop mark" in line 1 be deleted and replaced with --a crop mark-- since no crop mark was previously recited in the claim.

With respect to each of the dependent claims 2-15 and 17-18, it is suggested that the term "A" at the beginning of each claim be deleted and replaced with --The-- since the process was previously recited in the respective parent claim.

With respect to claim 7, the term “said printing couple” in line 3 has no proper antecedent basis since no printing couple was previously recited. To correct this problem, it is suggested that the word “said” be deleted from this term. Additionally in line 3, it is suggested that the term “a web” be deleted and replaced with --the web-- since the web was previously recited in claim 1. Also, in line 7, it is suggested that the phrase --and/or at least one other web strand-- be inserted into the claim after “strand” since that is how the converging step was recited in the parent claim. Also in line 7, it is suggested that the term “a bundle” be deleted and replaced with --the bundle-- since the bundle was previously recited in claim 1. Additionally, in line 8, it is suggested that the term “said” be deleted and replaced with --said-- to correct an obvious typographical error. Finally, in line 11, it is suggested that the term “it” be deleted and replaced with the structure to which “it” is intended to refer to provide more clear claim language.

With respect to claim 13, again it is suggested that the term “it” be deleted and replaced with the structure to which “it” is intended to refer.

With respect to claim 14, it is suggested that the term --first-- be inserted before “web” (second occurrence) in line 3 to insure it is clear as to which web strand is being referred to since a first and second web strand have been previously recited.

Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5-10 and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Elkotbi et al. (US 2003/0084765 A1).

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Elkotbi et al. teach a process for setting a crop mark in a printing production comprising cutting (with web slitter 136) the web 10 lengthwise into at least first and second web strands 120, converging at least the first and second web strands (at gathering point 140) to form a web strand bundle, cross-cutting (with cross-cutter 110) the web strand bundle between prints, adjusting lengths of paths of the web strands of the bundle before the convergence by path length changes (using the individual path length variation

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devices 26) that are selected to be such that crop mark positions of the web strands related to the cross-cutting are set, and selecting the path length change for one web strand to be such that a greatest of the path length changes is smaller than it would be if the path length change of the first web strand were not adjusted. Note that Elkotbi et al. teach each of the paths are individually changed by the path length variation devices 26 such that the adjustment travel can be minimized, as disclosed in paragraphs 0021-0025.

With respect to claims 5 and 10, note that it appears that none of the web strands of Elkotbi et al. are turned before convergence.

With respect to claims 6, note paragraphs 0026-0027 in particular.

With respect to claim 7, note the path length variation devices 26 of Elktobi et al. include deflecting means forming a deflection axis that is adjustable at right angles to an axial direction by a maximum adjusting length and the adjusting path lengths can be split between the deflecting means of all the web strands of the bundle.

With respect to claim 17, note Elktobi et al. teach a measuring of a deviation of the cropmarks using the sensors 34, 36 and adjusting the lengths of the paths according to the deviation. Since all of the paths are individually adjusted, it would inherently include the individual changes in the lengths to be less than the deviation.

6. Claims 1-3, 6-9, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Niedermaier et al. (US 5,123,316). Niedermaier et al. teach a process for setting a crop mark in a printing production comprising cutting the web 1 lengthwise (at slitting unit 8) into at least first and second web strands, converging at least the first and second web strands (at pull roller 57) to form a web strand bundle, cross-cutting the web strand bundle (with cross-cutter 19) between prints, adjusting lengths of paths of the web strands of the bundle before the convergence (with strip register rollers 26, 27 and part paper web controlling and adjusting device 65) by path length changes that are selected to be such that crop mark positions of the web strands related to the cross-cutting are set, and selecting the path length change for one web strand to be such that a greatest of the path length changes is smaller than it would be if the path length change of the first web strand were not adjusted. Again since both path lengths are individually changes (see column 5, lines 48-63 in particular), the path length change of one web strand is inherently set such that the greatest of the path length changes is smaller than it would be if the path length of one of the web strands was not adjusted.

With respect to claims 6-7 and 17, note the crop marks positions on the web strands are detected by reading heads 59 and the strip register rollers (i.e., deflecting means) are adjusted at right angles to an axial direction by a maximum adjusting path length such that the adjusting path lengths may be split between the deflecting means of all web strands of the bundle.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,748,857. Although the conflicting claims are not identical, they are not patentably distinct from each other because they each encompass a crop mark setting process including cutting the web lengthwise into at least two web strands, converging the web strands to form a web strand bundle, cross-cutting the web strand bundle, and adjusting the lengths of paths of each of the web strands before the convergence such that a greatest of the path length changes is smaller than it would be if the path length of one web strand were not adjusted.



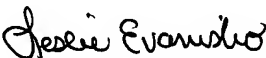
***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Okamura (US 5,119,725), Ogawa et al. (US 6,321,650), Hern (US 5,289,770), and Mustin et al. (US 2,214,593) each teach a crop mark setting process having obvious similarities to the claimed subject matter.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
September 30, 2004